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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/945,361

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James Robert Kitchen

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01/30/2003

B. Noel Kivlin  
Conley, Rose, & Tayon, P.C.  
P.O. Box 398  
Austin, TX 78767

EXAMINER

PAIK, STEVE S

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,361

Applicant(s)

KITCHEN, JAMES

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on two applications filed in the United Kingdom on August 31, 2000 and January 17, 2001. It is noted, however, that applicant has not filed a certified copy of the 0021456.9 and 0101215.2 applications as required by 35 U.S.C. 119(b).

### ***Claim Objections***

2. Claim 11 is objected to because of the following informalities: the word, "the notch" in line 7 would more precisely describe the claim if it gets changed to -- a notch --. Appropriate correction is required.

3. Claim 21 is objected to because of the following informalities: the word, "a device" in line 6 on page 21 would more precisely describe the claim if it gets changed to -- the device --. Appropriate correction is required.

Wakabayashi discloses a portable (a pocket size information transfer apparatus) comprising a circuit (IC chip inherently comprises an electronic circuit and its interfaces), a circuit interface (such as input/output terminals 13 in Fig. 2) and an opening (39 in Fig. 8 or 47 in Fig. 13) at an edge of the device, the opening being configured to be engaged by a restraint (lever 20) when the device is located at a device reading station (IC card operation unit for reading and writing electronic information) for retaining the device at the device reading station.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-12, 18-25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 5,991,875) in view of Wakabayashi et al. (US 6,454,164).

Re claim 1-5, 8-12, 18-25, 28 and 29, Paul discloses an apparatus and a method of securing a smart card (18 in Figure 4B) being used as a system configuration card (col. 3, lines 37-50) for the purpose of enabling a computer to boot up with the computer as configured in accordance with a user's system configuration preference. The system configuration card is providing an easy and quick reconfiguration process based on the reconfiguration preference stored in the card memory. The card comprises a circuit (memory 20), circuit interface (22). The system configuration card is not only applicable for reconfiguring a computer system, but also for a set top box for a television or televisions accessing the Internet or a particular television program (col. 2, lines 15-21). The system configuration card is inserted into a card-receiving slot (16) coupled to a reading and computing system (10). The reading system is coupled to the circuit interface when the system configuration card is inserted. Furthermore, the reading and computing system retrieves a particular configuration data stored in the inserted (through a slot 16) system configuration data card via the communication interfaces (22).

However, he fails to disclose the smart card device having an opening at an edge of the device.

Wakabayashi discloses a portable (a pocket size information transfer apparatus) information storage and its wall mountable reader (1) comprising a circuit (IC chip inherently

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comprises an electronic circuit and its interfaces), a circuit interface (such as input/output terminals 13 in Fig. 2) and an opening (39 in Fig. 8 or 47 in Fig. 13) at an edge of the device, the opening being configured to be engaged by a restraint (lever 20) when the device is located at a device reading station (IC card operation unit for reading and writing electronic information) for retaining the device at the device reading station. The opening (notch 39 or 47) has a shape that fits onto a round portion of a lever (20) to ensure a proper insertion of the card (col. 6, lines 24-28) and a fulcrum (23a) coupled to a detection switch.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated an opening, a recess, or a notch at an edge of a smart card to provide a secure insertion of the card to its reading device. Such modification is an obvious matter of design variation well within the ordinary skill in the art for the purpose of keeping the inserted smart card in the reader in a secure and detectable manner.

Re claim 6, Paul in view of Wakabayashi et al. discloses the card is rectangular (see Fig. 8 and 13), having two shorter edges at opposite ends of the card and two longer edges at opposite sides of the card, the notch (47) being provided in one of the shorter edges.

Re claim 7, Paul in view of Wakabayashi et al. discloses the circuit interface (33) comprises circuit contacts towards one of the shorter edges (see Fig. 13) at one end of the card, the notch (47) being formed in the shorter edges at the other end of the card.

6. Claims 13-17, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 5,991,875) as modified by Wakabayashi et al. (US 6,454,164) as applied to claim 9 above, and further in view of Fujita et al. (US 4,774,399). The teachings of Paul in view of

Wakabayashi et al. have been discussed above. Paul in view of Wakabayashi et al. discloses all the features of claimed invention with the exception of the formation having a hole.

Fujita et al. discloses a mechanism for preventing erroneous insertion and ejection of a memory card in figures 1-8. In particular the figure 8 clearly discloses a hole that passes between opposite surfaces of the formation (18) and through the passage at a position corresponding to that occupied by the opening (40) in the device (10) when the device is received at a reading position in the reading station (12). The hole is serving the purpose of securely holding the device while it is being read at the reading station. Fujita et al. further discloses a restraint (30 in Fig. 10) that is manually insertable through the hole to engage the opening (40) in the device, thereby retaining the device (10) in the reading station (12), where the restraint is a padlock. It is well known and obvious to use other types of holding mechanism as shown in above prior art of the references.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated a hole within a memory card, as taught by Fujita et al. for the purpose of keeping the card at a reading position securely. Such modification is an obvious matter of design variation well within the ordinary skill in the art for the purpose of keeping the inserted smart card in the reader in a secure and detectable manner.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Leung (US 5,242,310) discloses an I/O card for use in a computer or electrical device including a circuit board and interfaces.

Kumar (US 5,265,951) discloses a wall mountable card reading device.

Naruse et al. (JP 402018691 Abstract) discloses an IC card reader, an IC card comprising a notched part, a card stopper and lock claw to prevent the card from being put off during an access.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6893 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

*Steven Paik*

Steven S. Paik  
Examiner  
Art Unit 2876

ssp  
January 23, 2003



KARL D. FRECH  
PRIMARY EXAMINER